

REMARKS

This paper is responsive to the Office Action dated January 2, 2009.

The Examiner has objected to the form of the abstract. A new abstract is hereby submitted.

Additionally, responding to the Examiner's requirement, a reference to the related international application is inserted in the specification. Also, a minor correction is made to a statement at line 18 on page 1 of the specification.

The Examiner has required an election from among the following species:

(A) Figures 1-4;

(B) Figures 5-7;

(C) Figures 8, 9; and

(D) Figures 10, 11

As required, Applicant elects Species B. Claims 1-2 and 4 read on Species B. As noted by the Examiner, at least claim 1 is generic.

This election is made **with traverse**. It is respectfully submitted that the requirement for election is improper.

Specifically, as noted this application is a national phase of a PCT application. No lack of unity of invention was found in the PCT application. As stated in paragraph 138 of the PCT Applicants' Guide (copy attached), an international application which complies with the unity of invention requirements of Rule 13 must be accepted by all of the designated and elected offices. See, additionally, MPEP Section 1850(I). Accordingly it is inappropriate for the USPTO to assert lack of unity of invention in this national phase application.

In accordance with the foregoing, it is respectfully submitted that the election requirement should be withdrawn and all claims examined on the merits. Favorable consideration is respectfully solicited.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Charles Gorenstein, Reg. No. 29, 271 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: February 2, 2009

Respectfully submitted,

By  _____
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133. What is permitted under the “Markush Practice”? Rule 13.2 also governs the “Markush practice” wherein a single claim defines alternatives of an invention—a common drafting practice for inventions in the chemical field. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, is considered to be met when the alternatives are of a similar nature.

134. When the Markush grouping is for alternatives of chemical compounds, they are regarded as being of a similar nature where the following criteria are fulfilled:

- (i) all alternatives have a common property or activity, and
- (ii) (a) a common structure is present—that is, a significant structural element is shared by all of the alternatives, or
- (b) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

135. When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention will be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity will be raised.

136. Can both intermediate and final products be claimed? The situation involving intermediate and final products is also governed by Rule 13.2. The term “intermediate” is intended to mean intermediate or starting products. Such products have the ability to be used to produce final products through a physical or chemical change in which the intermediate loses its identity. Unity of invention should be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:

- (i) the intermediate and final products have the same essential structural element, in that:
 - (a) the basic chemical structures of the intermediate and the final products are the same, or
 - (b) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and
- (ii) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

137. Unity of invention may also be considered to be present between intermediate and final products of which the structures are not known—for example, as between an intermediate having a known structure and a final product the structure of which is not known, or as between an intermediate of unknown structure and a final product of unknown structure. In order to satisfy unity in such cases, there must be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product.

Article 2(x)
27(1)
Rule 13

138. An international application which complies with the unity of invention requirements laid down in Rule 13 must be accepted by all the designated and elected Offices, since Article 27(1) does not allow any national law (as defined in Article 2(x)) to require compliance with requirements relating to the contents of the international application different from or additional to those provided for in the PCT.

Rule 11
11.4(a)

139. What are the physical requirements for the claims? The physical requirements are the same as those for the description as outlined in paragraph 120. Note that the claims must commence on a new sheet.